

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBASIS MAJUMDAR, THOMAS M. LANEY,
JEHUDA GREENER, JOSE L. GARCIA,
and PETER T. AYLWARD

Appeal 2007-2152
Application 10/797,982
Technology Center 1700

Decided: August 3, 2007

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-11 and 14-16. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We reverse.

Appellants' invention relates to the field of imaging, e.g., photography, and the laminated base materials used in imaging elements (Specification 1:8-10 and 15). Independent Claim 1 is reproduced below:

1. A method of forming a roughened sheet comprising extruding a polymer sheet wherein at least one surface layer comprises polyether polymeric antistat, extrudable polymer, and compatibilizer stretching said polymer sheet by a ratio of at least 3:1 in at least one direction such that said at least one surface layer has a roughness of greater 0.3 Ra.

The Examiner relies on the following prior art reference to show unpatentability:

Greener US 6,207,361 B1 Mar. 27, 2001

The Examiner made the following rejection:

Claims 1-11 and 14-16 under 35 U.S.C. § 102(e) as anticipated by Greener.

ANALYSIS AND CONCLUSIONS

A reference is anticipatory within the meaning of § 102 if it discloses each and every claim limitation either expressly or inherently. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). In the present case, the Examiner attempts to establish anticipation of claims 1-11 and 14-16 by identifying portions of Greener which teach the individual components of Appellants' claimed method. The Examiner does not, however, direct us to a single working embodiment which includes *all* of the features recited in independent claim 1. *See Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 1000, 78 USPQ2d 1417, 1424 (Fed. Cir. 2006)

(the question is whether the prior art describes the claimed subject matter, or something falling within the claim, with sufficient specificity to anticipate the claim). In particular, none of Greener's examples includes a compatibilizer (Br. 4). Moreover, because the compatibilizer is absent from Greener's examples, the Examiner erred in concluding that Greener's material would inherently meet the claim limitations for surface roughness (Answer 5).

The rejection of claims 1-11 and 14-16 under 35 U.S.C. § 102(e) as anticipated by Greener is reversed.

REVERSED

clj

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